Brown, Brian (TM)

From: TMFeedback
Sent: Monday, January 10, 2011 9:29 AM
To: Brown, Brian (TM)
Subject: FW: Small Business Study

From: Groos, Richard (b)(6)
Sent: Friday, January 07, 2011 6:43 PM
To: TMFeedback
Cc: Groos, Richard
Subject: Small Business Study

Dear Sirs:

One of clients, a Fortune 500 company, responds to the survey as follows:

The survey begins with several assumptions. First, that this issue occurs. Second, that it occurs to such a degree that it must be addressed by Congress and other agencies. And third, that it is perpetrated by large companies upon small companies. Whether any of these assumptions are correct, however, is questionable.

Trademark owners are entitled to enforce their rights, regardless of the nature of any particular claim or the size of the defendant. Questions of infringement are subjective and depend on complicated analysis of many factors. This guarantees that reasonable parties can disagree, and makes it impossible to easily categorize claims in the black-and-white manner suggested by the questions in this survey. The legitimate scope of trademark rights is frequently misunderstood. Accordingly, businesses may question when trademark owners seek to assert their rights in ways the alleged infringer perceives as overreaching, regardless of how sound such claims may be under trademark jurisprudence. There is nothing inherent in the trademark arena that disproportionately permits or encourages abusive tactics. In fact, our experience is that abusive litigation tactics are less common in the trademark area than in other areas of the law (e.g., personal injury).

Furthermore, the current survey is unlikely to produce reliable results. It asks for anecdotal evidence of bad behavior, but makes no attempt to scientifically determine whether any of such anecdotes actually are representative of widespread behaviors.
The survey also overlooks the fact that trademark law requires mark owners to police their marks and pursue potential infringers or risk erosion or complete loss of their rights. Trademark owners are accordingly required to pursue claims that pose a potential threat to their business.

Finally, a strong argument can be made that the recent growth of social media has actually reduced the incidence of bullying, while simultaneously increasing the publicity attendant to the few instances of real bullying. This phenomenon is likely to be more effective than any action the USPTO or Congress might take on the matter.

The courts have the ability to dismiss unfounded claims and even to award attorneys' fees under 15 U.S.C. §1117(a) and under Rule 11 of the Federal Rules of Civil Procedure where appropriate. There is nothing to suggest that these mechanisms are inadequate, and courts and litigants should continue to use these mechanisms. Congress and the PTO should not, however, take action based on anecdotes,

unsubstantiated opinions and hearsay that will discourage trademark owners from pursuing legitimate claims. The PTO has a mission to determine and administer the registrability of marks, rather than to police behavior by litigants in civil actions.

Regards,

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(b)(6)

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